

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	Group Art Unit: 1618
)	
UBER et al.)	Confirmation No. 4883
)	
Serial No. 10/798,876)	Examiner: <i>Perreira, Melissa Jean</i>
)	
Filed: 11 March 2004)	Docket No. VI/02-002.PCT.US.C
)	
Title: APPARATUS, SYSTEM AND METHOD)	
FOR GENERATING BUBBLES ON)	
DEMAND)	Date: 28 August 2007

MAIL STOP AMENDMENT
COMMISSIONER FOR PATENTS
P.O. Box 1450
ALEXANDRIA, VA 22313-1450

RESPONSE TO ELECTION REQUIREMENT
AND
REQUEST FOR PARTIAL RECONSIDERATION THEREOF

Dear Sir/Madam:

In an Office Action mailed 29 May 2007, the Examiner alleges that the application contains claims directed to several patentably distinct species of invention. Specifically, on pages 2-3 of the Office Action, the Examiner asserts that the application contains claims directed to twelve (12) independent and distinct inventions.

- I. Claims 1-41 and 104-143 are drawn to a system for creating bubbles, classified in class 424, subclass 9.52.
- II. Claims 42-85 are drawn to a system for creating bubbles, classified in class 424, subclass 9.52.
- III. Claims 86-96 are drawn to a bubble generating apparatus, classified in class 424, subclass 9.52.
- IV. Claims 97-102 are drawn to a bubble generator, classified in class 424, subclass 9.52.
- V. Claims 103-111 are drawn to a bubble generator, classified in class 424, subclass 9.52.
- VI. Claims 112-115 are drawn to a bubble generator, classified in class 424, subclass 9.52.
- VII. Claims 116-118 are drawn to a bubble generator, classified in class 424, subclass 9.52.
- VIII. Claims 119-121 are drawn to a bubble generator, classified in class 424, subclass 9.52.
- IX. Claims 122-126 are drawn to a bubble generator, classified in class 424, subclass 9.52.

X. Claims 127-129 are drawn to a bubble generator, classified in class 424, subclass 9.52.

XI. Claims 130-133 are drawn to a bubble generator, classified in class 424, subclass 9.52.

XII. Claims 134-139 are drawn to a method of generating a medium of bubbles, classified in class 424, subclass 9.52.

Applicants herein respond to the election requirement. (As a sidenote, Applicants point out that Group I above is listed as consisting of "claims 1-41 and 104-143." Applicants proceed below on the assumption that "104" was a typographical error and that the intention was to have Group I encompass claims 1-41 and 140-143.)

I. FORMAL RESPONSE TO THE ELECTION REQUIREMENT INCLUSIVE OF ARGUMENTS IN SUPPORT OF PARTIAL WITHDRAWAL THEREOF

Formally responding to the election requirement, Applicants elect to prosecute the claims of Group I, namely claims 1-41 and 140-143, with traverse. Additionally, Applicants respectfully submit that the claims of Groups I and II should be joined as one group. This request is consistent with the requirements of M.P.E.P. §802.01, which states:

[An Examiner] may require restriction if two or more "independent and distinct" inventions are claimed in one application.

This, in turn, depends on the construction of the expression "independent and distinct" inventions."

The term "independent" (i.e., unrelated) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect.

Applicants respectfully submit that the inventions claimed in Groups I and II are related (i.e., not independent). To be independent, M.P.E.P. §802.01 requires that the two inventions must

be "unconnected in design, operation, and effect." Claim 1 of Group I is directed to a *"system for creating bubbles on demand for use within a medium administrable to a patient for purposes of a medical procedure...."* The sole independent claim (i.e., 42) of Group II is very similar in that it recites a *"system for creating a medium of bubbles on demand for administration to a patient for purposes of a medical procedure...."* The claims of Group I and II are, therefore, at the very least connected in "effect" in that, e.g., both inventions are directed to the creation of bubbled media to be administered to a patient during a medical procedure.

The independent claims of Groups I and II are also connected in "design" and "operation." Claims 1 and 42 each have the following common design elements: a *"reservoir,"* a *"pressurizing unit,"* a *"bubble generator,"* and a *"controller."* The common design elements in these claim groupings are also each connected in "operation" in that each *"reservoir"* is for holding a liquid, each *"pressurizing unit"* is for conveying the bubbled medium through the system, each *"bubble generator"* is for creating the bubbled medium, and each *"controller is for controlling operation of the system."*

Lastly, as requested herein, the partial withdrawal of the election requirement is further warranted under the regulations because the Examiner will suffer no "serious burden" if the election is not required between Groups I and II. Given the great similarity

between claim 1 of Group I and claim 42 of Group II, the search criteria will be identical for both groups of claims.

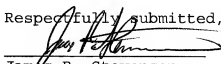
In view of the foregoing arguments, Applicants respectfully request that claims 42-85 of Group II above should be rejoined with claims 1-41 and 140-143 of Group I. Consequently, the election should now encompass claims 1-85 and 140-143.

As for the claims of Groups III-XII (i.e., 86-139), they are hereby withdrawn provisionally with traverse, with the understanding that they will be reinstated should it be determined that the regulations require rescission of the election requirement.

The Commissioner is hereby authorized to charge to Deposit Account No. 13-2530 any fees which may be required for consideration of this *Response To Election Requirement*.

If the Examiner has any questions regarding this *Response To Election Requirement*, he is invited to call the undersigned at the telephone number listed below.

Respectfully submitted,


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being electronically filed with the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on 28 August 2007.


Susan M. Lloyd